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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,647	04/27/2001	Sail Pradhan	1509-178	7844
7590	01/08/2004		EXAMINER	
LOWE HAUPTMAN GILMAN & BERNER, LLP			HOOSAIN, ALLAN	
Suite 310			ART UNIT	PAPER NUMBER
1700 Diagonal Road			2645	
Alexandria, VA 22314			DATE MAILED: 01/08/2004	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/843,647	PRADHAN ET AL.
Examiner	Art Unit	
Allan Hoosain	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

## **Disposition of Claims**

4)  Claim(s) 1-59 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-20,22-24,26-33,35,36,39,40 and 42-59 is/are rejected.

7)  Claim(s) 21,25,34,37,38 and 41 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 27 April 2001 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_.  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6)  Other: \_\_\_\_.

**DETAILED ACTION**

***Allowable Subject Matter***

1. Claims 21, 25,34,37-38,41 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 49 recites the limitation "the free form words" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7,9,31-33,35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by

**Settengren et al. (US 2002/0028674).**

As to Claims 1,4,31-33,35-36, with respect to Figures 1-4, **Slettengren** teaches a method of advertising comprising an advertiser telecommunications device, PZT 200, emitting an advertisement over a short range via a short range wireless transmitter, the advertisement having politeness requests (a characterisation profile) associated with it conveying information about the type of advertisements, of goods or services being offered or both (P0038);

    a consumer telecommunications device, 100, receiving the short range wireless advertisement (P0038);

    the consumer telecommunications device having a control profile (an advertisement filter) provided with an allowable politeness level (advertisement characteristics profile) and the consumer device comparing the received advertisement characteristic profile with its filter profile and accepting advertisements which match its advertisement characteristics profile to an acceptable degree and rejecting advertisements whose characteristics profile does not match to an acceptable degree (P0035 and P0039); and

    offering to present to a user the accepted advertisements received by the consumer device (P0040).

As to Claims 2-3, **Slettengren** teaches a method according to claim 1 comprising presenting the advertisements to the user via the consumer device, the consumer device comprising a hand-portable electronic device (Figure 1 and P0021).

As to Claims 5-7, **Slettengren** teaches a method according to claim 1 comprising interacting with an advertisement protocol manager system to set the consumer device advertisement characteristics filter profile, or the advertisement characteristics profile, or both (P0037).

As to Claim 9, **Slettengren** teaches a method according to claim 1 comprising presenting the advertisement to a user via a display screen of the consumer telecommunications device (p0040).

6. Claims 11-20,39,42-48,50-51,55-58 are rejected under 35 U.S.C. 102(e) as being anticipated by **Rautila et al.** (US 6,549,625).

As to Claims 11-12,14-16,18-20,39,42, with respect to Figures 1-4, **Rautila** teaches a method of advertising comprising communicating a first part of an advertisement from an advertiser telecommunications device to a consumer telecommunications device via wireless short range telecommunications, and the consumer device requesting a fuller advertisement or further details from an advertisement follow-up device (Figure 1 and Col. 8, line 63 through Col. 9, line 11).

As to Claims 13,17, **Rautila** teaches a method according to claim 11 comprising using short range wireless telecommunications to communicate the request for further details from the consumer device to the advertisement follow up device (Figure 1, label 27').

As to Claims 43,45-46, with respect to Figures 1-4, **Rautila** teaches a mobile telephone or other mobile telecommunications device having both a long range telecommunications transmitter and

receiver, and a piconet telecommunications transmitter and receiver, a control processor, and a memory storage medium (Figure 1, label 16);

wherein the memory storage medium contains an advertisement to be transmitted via the piconet transmitter, said advertisement having associated with it a number of advertisement classification codes identifying one or more characteristics of the advertisement, the control processor being adapted to broadcast the advertisement over the piconet transmitter and being adapted to monitor piconet signals that are received by the piconet receiver for a reply (Col. 6, line 48 through Col. 7, line 11).

As to Claims 44, **Rautila** teaches a device according to claim 43, in which the control processor is adapted to recognise a piconet-received request for further information or a fuller advertisement and to cause such further information or fuller advertisement to be emitted automatically upon receipt of a request for it (Col. 9, lines 1-11).

As to Claim 47, with respect to Figures 1-4, **Rautila** teaches an advertisement protocol management server having an input connectable to remote telecommunication devices, and an output connectable to remote telecommunications devices, and a control processor; and wherein said control processor has access to an allowable controlled and restricted set of allowed advertisement categories and is capable of

(i) operating on an input advertisement input to the server via said input to produce an output advertisement which has associated with it an appropriately selected subset of allowed

advertisement categories, and to output said output advertisement via said output (Col. 6, lines 23-67 and Figure 1); or

(ii) communicating with a remote telecommunications device via said output to allow said remote telecommunications device to construct an advertisement filter, either on the remote device or on the server, the filter comprising a selected subset of said allowable advertisement categories, and the selected processor being capable of passing the filter to the remote device; or  
(iii) performing both task (i) and task (ii).

As to Claim 48, **Rautila** teaches a server according to claim 47 having a data base of allowable advertisement categories (Figure 1, label 20).

As to Claim 50, **Rautila** teaches a server according to claim 49 which is adapted to act as an advertisement broker device adapted to receive one of (i) an advertisement message or (ii) a reply message to an advertisement and to forward the received message to a remote telecommunications device; the server being adapted to modify the received message so as to ensure no telecommunications address is passed with the message that is transmitted by the server (Col. 7, lines 12-22).

As to Claim 51, **Rautila** teaches a server according to claim 50 which is adapted to store the direct telecommunications address of the provider of the message and to recall that address and forward it to a remote telecommunications device if a release signal has been received by the server (Col. 7, lines 12-22).

As to Claims 55-56, **Rautila** teaches a method of creating an advertisement on a position transceiver (telecommunications device), 14, the method comprising having the position transceiver (device) submit a free form advertisement to a database (an advertisement writer tool), 26, and having the database (tool) assess the advertisement and allocate to it a selected advertisement subset of a set of allowable advertisement characterization categories, and the database (advertisement writer tool) communicating the selected advertisement subset of allowable advertisement categories to the position transceiver (telecommunications device) (Figure 1 and Col. 8, line 63 through Col. 9, line 11).

As to Claim 57, **Rautila** teaches a method of creating a memory (an advertisement filter), 26, on a position transceiver (telecommunications device), 14, the method comprising connecting the device to an information source (remote filter - creating device), 32, via telecommunications; creating a subset of allowable advertisement categories by selecting, via the telecommunications device, the subset from a master set of possible advertisement categories held on the filter creating device (Col. 7, lines 12-22); transmitting the subset of allowable categories to the telecommunications device to create the filter on the telecommunications device and storing the filter on the telecommunications device (Col. 8, lines 2-18).

As to Claim 58, **Rautila** teaches a method according to claim 57 in which the service provider, or advertisement writer/filter creator tool comprises the same device which has identification

information (a common allowable list of categories) and advertisements, emergency calls (standard keywords) (Col. 6, lines 48-60 and Col. 8, lines 13-18).

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 8,10,23-24,26-30 rejected under 35 U.S.C. 103(a) as being unpatentable over **Slettengren** in view of **Rautila et al.** (US 6,549,625).

As to Claims 8,23-24,26,27-29, **Slettengren** teaches a method according to claim 1 comprising:

**Slettengren** does not teach the following limitation:

“replying to an advertisement via the consumer telecommunications device”

**Rautila** teaches the limitation (Col. 8, line 63 through Col. 9, line 11). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add reply capability to **Slettengren's** invention for obtaining more detailed information as taught by **Rautila's** invention in order to provide complete linkage to detailed sources of information.

As to Claim 10, **Slettengren** teaches a method according to claim 1 comprising:

**Slettengren** does not teach the following limitation:

“the user manually selecting adverts for further investigation”

**Rautila** teaches the limitation (Figure 3 and Col. 9, lines 12-20). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add select capability to **Slettengren's** invention for obtaining more detailed information as taught by **Rautila's** invention in order to provide users with picking and choosing interesting information.

As to Claim 30, **Slettengren** teaches a method according to claim 1 comprising using portable electronic devices for both the advertiser device and the consumer device,

**Slettengren** does not teach the following limitation:

“the devices both having both piconet short range and long range telecommunication capabilities”

**Rautila** teaches a consumer device, like **Slettengren**, having short range and long range capabilities. In addition, unlike **Slettengren**, **Rautila** teaches an advertiser device, 16, with short

range and long range communications (Figure 1, labels 30 and 14). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add communications capability to **Slettengren**'s invention for updating advertiser information as taught by **Rautila**'s invention in order to provide users with advertising information.

10. Claims 22,40,52-54,59 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rautila** in view of **Slettengren**

As to Claims 22,40, **Rautila** teaches a method according to claim 11 in which the consumer device has:

**Rautila** does not teach the following limitation:

“an advertisement filter and filters incoming advertisements and only requests fuller details, or further details, of advertisements that pass a screening selection”

**Slettengren** teaches politeness levels (advertisement filters) which screens incoming communications (PP0031-P0035). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add politeness level capability to **Rautila**'s invention for accepting or rejecting advertiser information as taught by **Slettengren**'s invention in order to provide users with select advertising information.

As to Claims 52-54, **Rautila** teaches a network comprising an advertiser device comprising a telecommunications device, having both a short range transmitter and receiver, and also a long range telecommunications transmitter and receiver, a memory, and a control processor;

the memory including an advertisement which comprises at least an advertisement category profile containing a subset of possibly allowable advertisement categories; a consumer device comprising a telecommunications device, having both a short range, e.g. piconet, transmitter and receiver, and also a long range telecommunications transmitter and receiver, a memory and a control processor,

**Rautila** does not teach the following limitations:

“the memory or the processor having an advertisement filter which, in use, compares an advertisement category profile with a filter profile of a subset of allowable advertisement categories, or specifically rejected advertisement categories, and determines whether an advertisement received by the consumer device is an advertisement that the filter will pass or reject, the control processor being arranged to draw to the attention of the user of the consumer device, in use, the presence of an allowable advertisement that has been accepted by the filter”

**Slettengren** teaches politeness levels (advertisement filters) which screens incoming communications (PP0031-P0035). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add politeness level capability to **Rautila**’s invention for accepting or rejecting advertiser information as taught by **Slettengren**’s invention in order to provide users with select advertising information.

As to Claim 59, **Rautila** teaches the network of claim 52 wherein each of the telecommunications devices includes a hybrid mobile telephone (Col. 6, lines 40-47).

*Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Cannon et al.** (US 6,650,871) teach mobile terminals which communicate with short and long range transceivers.

**Liu et al.** (US 2002/0077896) teach an electronic billboard which communicates filtered advertisements to mobile users.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

**Or:**

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

*Allan Hoosain*  
**Allan Hoosain**  
**Primary Examiner**  
**1/5/04**